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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,901	12/27/2001	George Cintra	08935-249001 /M-4965	1584
26161	7590	10/31/2005	EXAMINER	
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			ALEJANDRO, RAYMOND	
		ART UNIT	PAPER NUMBER	
		1745		

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/034,901

Applicant(s)

CINTRA ET AL.

Examiner

Raymond Alejandro

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) The period for reply expires _____ months from the mailing date of the final rejection.
 b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) They raise the issue of new matter (see NOTE below);
 (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. Applicant's reply has overcome the following rejection(s): _____.

6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,3,4,9-11,14,15 and 46-62.

Claim(s) withdrawn from consideration: 5-8, 12-13.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see next page.

12. Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.

13. Other: _____.

RAYMOND ALEJANDRO
PRIMARY EXAMINER

Raymond Alejandro
Primary Examiner
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Response to Arguments

1. Applicant's arguments filed on 10/14/05 have been fully considered but they are not persuasive.
2. The main contention of applicant's arguments appears to be premised on the assertion that there is no motivation to appositely combine the two main references, one way or another. The examiner strenuously but respectfully disagrees with applicants' position. In that, it is first noted that applicant has elaborated a lengthy explanation of why the sputtering deposition of Johnson and the protective coating of Fukumura, *inter alia*, cannot be combined together. Other than subjectively asserting a lack of motivation based upon a reasonable expectation of success thereof, applicant's arguments offer nothing more than the very same arguments already presented by the applicants in prior office actions. To that extent, applicant is kindly reminded that the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Additionally, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. (*Emphasis added*→)
Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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3. In further response to applicant's arguments that "*the Examiner has not established a reasonable expectation of success of the combination*", the fact is that applicants have not also established a reasonable expectation of failure of the combination, that is, why the teachings of the two main references cannot be combined, one way or another. To be precise, a statement or argument by the attorney is not factual evidence. (See **MPEP 716.01 and 2145 Consideration of Applicant's Rebuttal Arguments**).

4. Moreover, given that the claims of the present invention fail to fairly stipulate what is the specific layer formation technique, applicant's arguments are not commensurate in scope with the present claim language. Nothing in the present claims clearly defines whether sputtering is or is not employed for layer formation purposes. Thus, applicant's arguments for the sake of arguing *[sic]* something against one of the main reference is ill-placed. Applicant is also reminded that in order to fully discredit one reference against the claimed invention, the very same claimed invention at best must suggest or recite something about the "discrediting element". Otherwise, the broadest reasonable interpretation of the prior art can be applied to that claimed invention congruent with the breadth of the present claims. Succinctly stated, in this instance, the subject matter of the claimed invention does not describe any layer formation technique, and thus, it is unreasonable that applicants attack or squeeze the references in order to overcome the prior rejection by merely indicating that either: a) they do not teach applicant's unclaimed layer formation technique, or b) the layer forming technique of the two references are dissimilar. This argument is deemed ineffective, inapplicable and inapt to overcome the prior art rejections.

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5. Additionally, applicants have contended that “Fukumura expressly recites that there are a layer containing an active material and a layer containing no active material...Fukumura then discusses several ways in which the layer containing no active material is used”. All over again, applicant’s arguments are not commensurate in scope with the subject matter recited independent claim 1 which is completely silent about the electrochemical activity of the layer material. That is, independent claim 1 only recites “a first layer comprising a cathode mixture on a substrate”. To the best of the examiner knowledge, a cathode mixture is in fact a mixture per se which can be used in a cathode. It is not an electrochemically active material. Period. The electrochemical activity of the cathode mixture as instantly argued by the applicants is irrelevant to the patentability of independent claim 1 simply because said claim does not positively recite so. That being said, applicant is respectfully requested to provide serious and accurate responses by carefully reviewing the scope of the presently claimed invention, and thus, providing arguments commensurate thereto. It is unfair to submit responses arguing that the claimed invention recites a substantial number of limitations/features: A, B, C, D, E, W, X, Y, Z; but only and ultimately claiming limitations/features: A, B, C; and nothing more, nothing less.

The following responses to applicant’s arguments were discussed in the final rejection of 09/19/05 and are herein presented one more time as they are deemed to be related to applicant’s current arguments:

6. The principal contention of applicant’s arguments is based on the assertion that there exists no motivation to combine the references in either way (*i.e. a) Johnson in view of Fukumura, or b) Fukumura in view of Johnson, c) or Johnson in view of Hamamoto*). In response to

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applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

As for the use of Fukumura as the secondary reference, the examiner simply points out that the Fukumura reference has been cited infra to merely demonstrate and show that cathode slurry mixed materials can be used to coat electrode substrates. Applicant's analysis that the coating solution of Fukumura contains no active material is in error. In this regard, it is noted that Fukumura et al explicitly disclose that coated layers may contain an active material itself or no active material at all (See Fukumura et al, COL 4, lines 15-23). Moreover, Example Positive Electrode 1 at column 6, lines 34-45 also clearly shows that active material, binders and solvents are mixed to provide a slurry of a coating solution for a positive electrode material. Thus, applicant's arguments that the slurry of Fukumura et al contains no active material are inapposite and misleading. Applicant is respectfully requested to carefully and thoroughly read the aforementioned sections of the Fukumura et al reference.

As far as Johnson being applied as the secondary reference, applicant has contended that "*Johnson et al does not teach that the removal of the current collector is in any way desirable*" and "*One of skill in the art would not have been motivated to remove the current collector of the Fukumura electrode sheet*". However, applicant's arguments are not understood by the examiner and are out of the scope of the presently claimed invention. There is nothing in the present claim

language directed to current collectors, as such, what do current collectors of Johnson et al and/or Fukumura et al have to do with the scope of the present invention? Nevertheless, the examiner likes to furnish the applicant the following information: test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art (*←Emphasis added*). See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

7. In response to applicant's argument about "*a minimal volume of inactive material*" and/or "*the increase in volume of inactive materials*", the fact that applicant has recognized another advantage/disadvantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

8. In response to applicant's arguments that "*there is nothing in either Johnson or Fukumura to suggest that such sputter deposition can successfully be employed using a slurry target rather than a solid target, and the Examiner has presented no alternative factual support for the proposition that sputtering a slurry is feasible*", the examiner likes to counter-argue substantially the opposite, in particular, there is also nothing in either Johnson or Fukumura to suggest that such sputter deposition cannot successfully be employed using a slurry target rather than a solid target, and applicant or his legal representative has presented no alternative factual support for the proposition that sputtering a slurry is not feasible. Currently, there is no sound or factual evidence to either believe or disbelieve, credit or discredit, that the step of sputtering a

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slurry is feasible or not. Thus, since PTO, and obviously the Examiner in charge of prosecuting the instant application, does not have proper equipment or instruments to carry out the analytical test or experiments, the burden is shifted to applicant to supply objective or factual evidence demonstrating why sputtering a slurry is not feasible.

By the way, the examiner also asserts that it is not enough that applicant's representative personally believes that sputtering a slurry is not feasible. That is to say, the arguments of counsel cannot take the place of evidence in the record. An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of inherent anticipation/obviousness (See **MPEP 716.01 and 2145: Consideration of Applicant's Rebuttal Arguments**).



RAYMOND ALEJANDRO
PRIMARY EXAMINER